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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,694	10/17/2000	Christopher R Lefebvre	47004.000062	2049

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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,694

Applicant(s)

LEFEBVRE ET AL.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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**WITHDRAWAL OF FINALITY OF PAPER FILED 4/30/2004
(REOPENING OF PROSECUTION /WITHDRAWAL FROM APPEAL)
NON-FINAL OFFICE ACTION REJECTION (PAPER FILED 8/23/2004)**

1. The finality of the rejection of the prior Office Action (filed 4/30/2004) on appeal (see paper filed 7/30/2004) is withdrawn because of new grounds of rejection herein presented.

STATUS

2. Claims 19-38 are pending.

DRAWINGS

3. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 19-38 are rejected under 35 U.S.C. §103(a) as being obvious over Eggleston 6,061,666 (05/09/2000) (herein referred to as "Eggleston").

As per independent claim 19, Eggleston (FIG. 8; FIG. 9; col. 7, ll. 18-25; and col. 45, l. 45-50) shows "[a] computer method for providing one or more tailored incentives to a customer in response to a customer request. . . ."

Eggleston (FIG. 8; FIG. 9; and col. 7, ll. 18-25) shows "receiving a request from a customer. . . ."

Eggleston (FIG. 7; FIG. 16; FIG. 17; FIG. 18; col. 3, ll. 65-67; and col. 4, ll. 1-18) implicitly shows "retrieving account data associated with the customer in response t the request where the account data is displayed on a graphical user interface. . . ."

Eggleston (col. 7, ll. 18-25; FIG. 24; FIG. 21; FIG. 20) implicitly shows "identifying the request as a request type, where the request type identifies the customer's current situation. . . ."

Eggleston (col. 12, ll. 57-67; col. 13, ll. 1-10; col. 16, ll. 45-67; col. 17, ll. 1-10; col. 1, ll. 35-47; col. 39, ll. 50-65; and col. 42, ll. 30-67) implicitly shows "identifying the customer as a customer segment, where the customer segment identifies the customer's past behavior. . . ."

Eggleston (FIG. 8; FIG. 9; and FIG. 20) implicitly shows "identifying one or more incentives based on the request type, the customer segment and one or more profitability

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factors associated with a provider of the one or more incentives; and offering the customer at least one of the identified one or more incentives for retaining the customer in response to the request.”

Eggleston lacks an explicit recitation of “identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives; and offering the customer at least one of the identified one or more incentives for retaining the customer in response to the request.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Eggleston (FIG. 8; FIG. 9; and FIG. 20; and whole document) implicitly shows “identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives; and offering the customer at least one of the identified one or more incentives for retaining the customer in response to the request. . . .”; and it would have been obvious to modify and interpret the disclosure of Eggleston cited above as showing “identifying one or more incentives based on the request type, the customer segment and one or more profitability factors associated with a provider of the one or more incentives; and offering the customer at least one of the identified one or more incentives for retaining the customer in response to the request. . . .”, because modification and interpretation of the cited disclosure of Eggleston would have provided “*a new incentive program and award system for using*

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a computer network, preferably the Internet, to provide consumer access to expanded incentive programs. . . .” (see Eggleston (col. 5, ll. 45-55)) based on the motivation to modify Eggleston so as to “build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs.” (See Eggleston (col. 5, ll. 50-55).

As per dependent claim 20, Eggleston shows the method of claim 19.

Eggleston (col. 33, ll. 38-52; and col. 35, ll. 2-20) implicitly shows “a request to terminate a relationship with the provider.”

Eggleston lacks explicit recitation of “a request to terminate a relationship with the provider.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Eggleston (col. 33, ll. 38-52; and col. 35, ll. 2-20; and whole document) implicitly shows “a request to terminate a relationship with the provider. . . .”; and it would have been obvious to modify and interpret the disclosure of Eggleston cited above as showing “a request to terminate a relationship with the provider. . . .”, because modification and interpretation of the cited disclosure of Eggleston would have provided “*a new incentive program and award system for using a computer network, preferably the Internet, to provide consumer access to expanded incentive programs. . . .*” (see Eggleston (col. 5, ll. 45-55)) based on the motivation to

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modify Eggleston so as to *“build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs.”* (See Eggleston (col. 5, ll. 50-55).

As per dependent claim 21, Eggleston shows the method of claim 19.

Eggleston (col. 4, ll. 33-55) implicitly shows “the one or more incentives comprises a product by a financial institution.”

Eggleston lacks explicit recitation of “the one or more incentives comprises a product by a financial institution.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Eggleston (col. 4, ll. 33-55; and whole document) implicitly shows “the one or more incentives comprises a product by a financial institution. . . .”; and it would have been obvious to modify and interpret the disclosure of Eggleston cited above as showing “the one or more incentives comprises a product by a financial institution. . . .”, because modification and interpretation of the cited disclosure of Eggleston would have provided *“a new incentive program and award system for using a computer network, preferably the Internet, to provide consumer access to expanded incentive programs. . . .”* (see Eggleston (col. 5, ll. 45-55)) based on the motivation to modify Eggleston so as to *“build, buy, store, modify, offer, track and administer incentive programs and to permit sponsors and retailers to offer improved*

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award fulfillment for participants in incentive programs." (See Eggleston (col. 5, ll. 50-55)).

As per dependent claims 22-28, Eggleston shows the method of claim 19.

Eggleston (FIG. 8; FIG. 9; col. 7, ll. 18-25; and col. 45, l. 45-50) inherently shows all of the elements and limitations of claims 22-28; however,

Eggleston lacks explicit recitation of some of the elements and limitations of claims 22-28.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations of claims 22-28 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Eggleston (FIG. 8; FIG. 9; col. 7, ll. 18-25; and col. 45, l. 45-50; and whole document) inherently shows all of the elements and limitations of claims 22-28; and it would have been obvious to modify and interpret the disclosure of Eggleston cited above as showing all of the elements and limitations of claims 22-28 because modification and interpretation of the cited disclosure of Eggleston would have provided "*a new incentive program and award system for using a computer network, preferably the Internet, to provide consumer access to expanded incentive programs. . . .*" (see Eggleston (col. 5, ll. 45-55)) based on the motivation to modify Eggleston so as to "*build, buy, store, modify, offer, track and*

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administer incentive programs and to permit sponsors and retailers to offer improved award fulfillment for participants in incentive programs." (See Eggleston (col. 5, ll. 50-55).

Independent claim 29 is rejected for the same reasons as independent claim 19.

Dependent claims 30-38 are rejected for the same reasons as dependent claims 20-28.

RESPONSE TO ARGUMENTS

5. Applicant's arguments (Appeal Brief, paper filed 7/30/2004) have been considered but are not persuasive for the following reasons:

Applicant's arguments are moot based on new grounds of rejection presented in this Office action.

CONCLUSION

6. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

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(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESC
PRIMARY EXAMINER

August 23, 2004